

REMARKS

Based on the amendments to the claims above, claims 1-9, 11-14, and 16-21 are pending, with claims 1, 12, 16, 18, and 20 being independent claims.

The only issues raised by the action are prior art rejections. Claims 1-3, 6, 12-18, 20, and 21 stand rejected as anticipated by Steinberg (U.S. Patent Application 2002/0028037). Claims 4, 5, 7-11, and 19 stand rejected as obvious over Steinberg either alone or in view of Dautartas (U.S. Patent 5,550,088).

Below we explain why each independent claim, as currently amended, differentiates the cited prior art.

Claim 1

Claim 1 includes features from claim 10 as originally filed. In addition to other features, claim 1 recites "said optical fiber extends between opposite ends of said fiber holder" and "said fiber holder is mounted to said base in contact with said additional spacer at one of said ends of said fiber holder" (emphasis added). In contrast, the section of Steinberg pointed to by the action (Fig. 14) shows guide balls 1415 contacting only the underside of waveguide holding members 1401 and 1402 - not any of their ends (see paragraphs 51 and 52 of Steinberg). Although claim 10 as originally filed stands rejected over Steinberg in view of Dautartas, we can find nothing in Dautartas, nor does the action point to any section of Dautartas, to remedy this distinction.

The action also points to Fig. 3 of Steinberg when making the anticipation rejection - for example, "The indentations formed in said base includes at least one indentation located adjacent to an edge of said base, the spacer within the indentation inherently establishes a known distance from a contact point on said spacer to a point on said base. See figures 3 and 14" (Paragraph 4 of the Action).

However, we point out that Figs. 3 and 14 correspond to different embodiments (see, e.g., paragraphs 18 and 22 in Steinberg). Moreover, the embodiments of Figs. 3 and 14 are fundamentally incompatible with one another. In particular, in the embodiment of Fig. 3 (and Figs. 1 and 2), waveguide holding members 201 and 202 move transversely with respect to one another to realize an optical switch (see, e.g., paragraph 35 and the transverse arrow in Fig. 2 in

Steinberg). On the other hand, in the embodiment of Fig. 14 (and Fig. 13), transverse motion of waveguide holding members 1401 and 1402 is prevented by guide balls 1415 in pits 1425 and recesses 1414, and the optical switch is realized by relative longitudinal motion between waveguide holding members 1401 and 1402 (see, e.g., paragraphs 49-51 and Figs. 13 and 14 of Steinberg).

Because Figs. 3 and 14 relate to different embodiments, and in particular, embodiments that are incompatible with one another, we submit that features shown therein cannot be combined with one another when making a rejection. See, e.g., Brown v. 3M, 265 F.3d 1349 (Fed. Cir. 2001) ("To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim") (emphasis added) and Ecolochem, Inc. v. Southern California Edison Co., 227 F.3d 1361 (Fed. Cir. 2000) (holding that the district court misconstrued the reference, erroneously linking one textual passage, which discussed several alternatives (hydrazine or hydrogen), and a later figure and accompanying text, which focused only on one of the alternatives (hydrogen))

Claim 12

In addition to other features, claim 12 recites "said optical device is mounted to said base with an edge of said optical device in contact with at least two of said second plurality of spacers" (emphasis added). In contrast, the section of Steinberg pointed to by the action (Fig. 14) shows guide balls 1415 contacting only the underside of waveguide holding members 1401 and 1402 - it does not show any of the guide balls contacting an edge of the waveguide holding members (see paragraphs 51 and 52 of Steinberg).

As described above with reference to claim 1, the action also points to Fig. 3 of Steinberg when making the anticipation rejection. However, as also described above, the embodiments of Fig. 3 and 14 in Steinberg relate to different, fundamentally incompatible embodiments. Therefore, features described therein cannot be combined with one another when making a rejection.

Claim 16

In addition to other features, claim 16 recites "said optical device is mounted to said base with said flat face [of said optical device] in contact with at least three of said second plurality of spacers" (emphasis added). In contrast, the section of Steinberg pointed to by the action (Fig. 14) shows guide balls 1415 contacting a plurality of "pits" 1425 in waveguide holding members 1401 and 1402 (see paragraphs 51 of Steinberg). Clearly such pits are contrary to the flat face contact required by the claim.

Claim 18

In addition to other features, claim 18 recites "one of said plurality of spacers held within the one indentation adjacent to the edge of said base protrudes beyond the edge of said base and establishes a known distance from a contact point on said spacer to a point on said base" (emphasis added). In contrast, the section of Steinberg pointed to by the action (Fig. 14) shows substrate 1400 having "pits" 1425 or recesses 1414 only within the perimeter of its top surface (see paragraphs 51 and 52 of Steinberg), therefore, it is impossible for any of guide balls 1415 to protrude beyond the edge of the substrate, when none of the pits or recesses even contact any such edge.

As described above with reference to claim 1, the action also points to Fig. 3 of Steinberg when making the anticipation rejection. However, as also described above, the embodiments of Fig. 3 and 14 in Steinberg relate to different, fundamentally incompatible embodiments. Therefore, features described therein cannot be combined with one another when making a rejection.

Claim 20

In addition to other features, claim 20 recites "wherein said base substrate further includes an elongate recess and wherein said plurality of optical devices fits into said recess." We cannot find such features in either Steinberg or Dautartas, nor does the action point to any section of these reference for finding such features.



**BEFORE THE OFFICE OF ENROLLMENT AND DISCIPLINE
UNITED STATE PATENT AND TRADEMARK OFFICE**

LIMITED RECOGNITION UNDER 37 CFR § 10.9(b)

Dr. Marc M. Wefers is hereby given limited recognition under 37 CFR §10.9(b) as an employee of Fish & Richardson P.C., to prepare and prosecute patent applications wherein the patent applicant is the client of Fish & Richardson P.C. and the attorney or agent of record in the applications is a registered practitioner who is a member of Fish & Richardson P.C. This limited recognition shall expire on the date appearing below, or when whichever of the following events first occurs prior to the date appearing below: (i) Dr. Marc M. Wefers ceases to lawfully reside in the United States, (ii) Dr. Marc M. Wefers' employment with Fish & Richardson P.C. ceases or is terminated, or (iii) Dr. Marc M. Wefers ceases to remain or reside in the United States on an H-1B visa.

This document constitutes proof of such recognition. The original of this document is on file in the Office of Enrollment and Discipline of the U.S. Patent and Trademark Office.

Expires: December 23, 2003

Harry I. Moatz

Director of Enrollment and Discipline